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Date: March 11, 2005

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Subject: Issue Fee and Publication Fee Transmittal
U.S. Patent Application No. 10/099,738
Filing Date: March 15, 2002
In re Application of: CHRISTIAN A. HEID et al.
Title: METHODS FOR EXTERNAL CONTROLS FOR NUCLEIC ACID
AMPLIFICATION

Our File: 4498 C1 US

No. of pages (including cover sheet): 7

Enclosures:

Issue Fee and Publication Fee Transmittal (1 page in duplicate);
Part B - Fee(s) Transmittal (PTOL-85) (1 page in duplicate); and
Comments on Statement of Reasons for Allowance (2 pages)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

CHRISTIAN A. HEID et al.

Serial No.: 10/099,738

Filed: March 15, 2002

For: **EXTERNAL CONTROL
REAGENTS FOR NUCLEIC
ACID AMPLIFICATION**

Confirmation Number: 5560

) Group Art Unit: 1637

) Examiner: JOYCE TUNG

) Allowed: December 21, 2004

CERTIFICATE OF MAILING Under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with
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COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE

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Sir:

In response to the Examiner's Reasons for Allowance mailed with the Notice of Allowance on December 12, 2004, Applicants thank the Examiner for allowing claims 1-31 of the instant case. For the sake of additional clarity, applicants wish to address two issues.

As a first matter, Applicants agree with the Examiner's Reasons for Allowance mailed December 21, 2004, including the indication that "Concerning claims 1-31, no prior art has been found teaching or suggesting the kit for nucleic acid amplification comprising a single stranded external control polynucleotide, a forward primer, a reverse primer and a detectable probe wherein the forward primer and the detectable probe are separated by 0-5 nucleotides when hybridized to the external control polynucleotide, and the reverse primer and the detectable probe are separated by 0-5 nucleotides when hybridized to the external control polynucleotide. The closest prior art is the reference of Aoyagi et al. (5952202, issued September 14, 1999)..."

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4498 CI US


In an earlier correspondence on August 30, 2004, applicants indicated that arguments made on May 6, 2003 remained in effect, specifically "applicants pointed out that their claimed invention, unlike Aoyagi, teaches the following element of claim 1 of the instant application, "wherein the forward primer and the detectable probe are separated by 0 to 5 nucleotides when hybridized to the external control polynucleotide, or its complement, and the reverse primer and the detectable probe are separated by 0 to 5 nucleotides when hybridized to the external control polynucleotide, or its complement." Applicants further noted on August 30, 2004, that additionally, 103(c) could be invoked, given the obligation of applicants to assign to the same entity as Aoyagi. However, in light of the Examiner's Reason for Allowance, and solely for the reasons of expediting allowance and minimizing unnecessary correspondence, applicants no longer consider it necessary to pursue this argument and its corresponding evidentiary support.

As a second matter, in the Notice of Allowability sent December 7, 2004, the Examiner indicates that "The drawings filed on 15 March 2004" are accepted by the Examiner." Applicants wish to note that no drawings were filed on 15 March 2004. Applicants presume that Examiner's statement pertains to the drawings filed with the application on March 15, 2002.

Applicants again thank the Examiner for allowing claims 1-31 of the instant case. An issue fee is hereby enclosed.

Respectfully submitted,

Date: 3-11-05


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Agent for Applicants

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